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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,277	07/30/2003	Alan Maki	110000-9408	8725

37374 7590 07/03/2007  
INSKEEP INTELLECTUAL PROPERTY GROUP, INC  
2281 W. 190TH STREET  
SUITE 200  
TORRANCE, CA 90504

EXAMINER

VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
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1732

MAIL DATE	DELIVERY MODE
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07/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/630,277	Applicant(s) MAKI ET AL.	
	Examiner Mathieu D. Vargot	Art Unit 1732	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 30-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

1. Claims 21-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites that the "photochromic laminate" includes a front and back resin sheet as well as the one functional layer, wherein the laminate has a thickness of from 5 to less than 50 microns. However, the instant specification can only support that the **functional layer itself** has this thickness, not the entire laminate, which also includes the front and back sheets. Clarification is required as to what exactly has the instant thickness in claim 21.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-29, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Bhalakia et al –459 or –446 in view of any of European patent Application 1,162,482, Nishizawa et al –383 or European Patent Application 1,273,935 essentially for reasons of record noting the following .

The references have been applied for reasons of record, except European –935 has been additionally applied to show the employment of only one functional film in the insert. Applicant has argued that the instant laminate contains only one functional layer. However, it is rather clear that one of ordinary skill in the art would eliminate any layers in the laminate not deemed to be necessary, and hence European –482 and Nishizawa,

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which are essentially cumulative with respect to each other, continue to be applied.

Applicant also argues that the laminate of Nishizawa has a thickness outside the claimed range. First of all, the thickness disclosed in the specification is that of the **polyurethane layer, not the thickness of the entire laminate**. Indeed, applicant uses layers that are 300 microns thick as the outer layers, as do the prior art. However, European –482 and Nishizawa et al employ a polyurethane layer with photochromic material that is at the lower end around 50 microns thick. While the instant claims call for less than 50 microns, it is submitted that something a little less than 50 would have been obvious over something a little more than 50 concerning the thickness of the polyurethane layer. In truth, there is no criticality for 50 microns in the instant specification. Examples 1A and 1B have 51 and 76 micron thick polyurethane layers and these produce an acceptable lens. It is only when the thickness greatly exceeds 50 microns that unacceptable lenses result. Also, European –935, newly applied, does not explicitly teach the thickness of the polyurethane layer, but does indicate that the polyurethane solution is coated to a thickness of 300 microns—see paragraph 0045 therein. It should be noted that the thickness of the coated solution in European –935 is similar to that disclosed in the other two secondary references (which teach a lower limit of 50 microns for the polyurethane layer) and indeed for that disclosed in the instant specification. See page 12, paragraph 44 of the instant specification, which teaches that the solution would be coated to a thickness of 500 microns before the solvent is driven off. Hence, it is submitted that the final film of European –935 would have an acceptable thickness to produce an acceptable lens. In summary, the prior art teaches

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polyurethane photochromic laminates that appear to differ at best only slightly in terms of thickness than those disclosed in the instant application of forming sharp segment lines and no bleeding. It is submitted that one of ordinary skill in the art would have realized that the films of the prior art, when laminated to a lens main body as taught in the primary references, would have yielded lenses with sharp segment lines and no bleeding. The exact properties of the polyurethanes would have been well within the skill level of the art, as it is within the purview of one to employ resin materials based on desired properties.

3. Applicant's arguments filed April 9, 2007 have been fully considered but they are not persuasive. Applicant's arguments have been essentially addressed in the rejection, *supra*. It is respectfully submitted that the secondary references do not have to show making a bifocal lens, since the primary references do this. The point is, when combined with the primary references, the secondary references meet the claimed limitations or render them obvious. Hence, it is believed that the combination would exhibit the instant properties of sharp segment lines and reduced bleeding. It is maintained that Nishizawa does not "teach away" from the instant invention as noted by applicant. A polyurethane photochromic layer of 51 microns works very well according to the instant specification—again, see instant Example 1A.

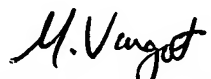
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot  
June 22, 2007

  
Mathieu D. Vargot  
Primary Examiner  
Art Unit 1732

6/22/07